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<u>IN THE UNITED STATES PATENT AND TRADEMARK OFFICE</u> JUN 2 3 2006

In re patent application of:	) Date: June 23, 2006
Edward P. Daniels Jr., et al.	) Attorney Docket No.: F-170
Serial No.: 09/862,377	) Customer No.: 00919
Filed: May 22, 2001	) Group Art Unit: 2167
Confirmation No.: 8688	) Examiner: Miranda Le

Title: SYSTEM AND METHOD FOR OBTAINING AND TRACKING UP-TO-THE-MINUTE DELIVERY LOCATIONS OF EMPLOYEES VIA A DATABASE SYSTEM

<u>TRANSMITTAL OF SUBSTITUTE APPELLANT'S BRIEF IN COMPLIANCE WITH 31 CFR 41.37(c)</u>

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is a **SUBSTITUTE APPELLANT'S BRIEF** in the above-identified patent application in response to an order mailed May 3, 2006.

The fee for filing the Appeal Brief has previously been paid.

The Commissioner is hereby authorized to charge any additional fees which may be required to Deposit Account No. **16-1885**.

Respectfully submitted,

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:	) Attorney Docket No.: F-170
Edward P. Daniels Jr., et al.	) Group Art Unit: 2167
Serial No.: 09/862,377	) Examiner: Miranda Le
Filed: May 22, 2001	) Date: June 23, 2006
Customer No.: 00919	) Confirmation No.:8688

Title: A SYSTEM AND METHOD FOR OBTAINING AND TRACKING UP-TO-THE-MINUTE DELIVERY LOCATIONS OF EMPLOYEES VIA A DATABASE SYSTEM

SUBSTITUTE APPELLANT'S BRIEF IN COMPLIANCE WITH 31 CFR 41.37(c)

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This correction is submitted in response to an order mailed May 3, 2006

requesting applicants to file the Appeal Brief under 37 CFR 41.37(c).

CERTIFICATE OF FACSIMILE

I hereby certify that this correspondence is being transmitted via facsimile to Mail Stop Appeal Brief – Patents, United States Patent and Trademark Office, (571) 273-8300.

On <u>June 23, 2006</u>
Date of Deposit

Signature

<u>Marlene Massop</u>
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<u>June 23, 2006</u>
Date

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I.   REAL PARTY IN INTEREST

Pitney Bowes Inc. is the real party in interest by way of assignment from the inventors.

II.   RELATED APPEALS AND INTERFERENCES

There are no related Appeals or Interferences.

III.   STATUS OF CLAIMS

A.)   Claims 1-10 are in the application.

B.)   Claims 1-10 are rejected.

C.)   Claims 1, 5, and 7-10 are in independent form.

IV.   STATUS OF AMENDMENTS

There are no pending amendments to the claims filed subsequent to the final rejection dated April 1, 2004. Therefore, the claims as set forth in Appendix A to this brief are those as set after the final rejection.

V.   SUMMARY OF CLAIMED SUBJECT MATTER

The present claimed invention provides a method and a computer system for locating, obtaining, and tracking delivery locations of employees via a corporate database system. The recipient is likely to be an employee of the corporation but it could be anyone who has provided their personal information, contact information, and

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location to the corporation, and who further has access to the computer based system of the present invention in order to update their schedule and delivery preferences. (See page 9, line 26 to page 11, line 15 of the Specification). This computer based system is capable of including all employees of a large corporation as potential recipients being tracked by the system. The method for locating a recipient of a message in a corporation using a computer based system involves compiling a database(s) of recipient's scheduled locations, recipient delivery preferences and the corporation's preferences. Access to the recipient location and delivery preferences database is provided to the recipients and the system administrator who can then update the recipient's scheduled locations and/or delivery preferences. Additionally, the present invention computer based system is provided access to a separate corporation schedule organizer and can update recipient's schedule in the corporate schedule organizer. The corporate schedule organizer is monitored for location change(s) in the recipients schedule and any location changes in the schedule are automatically updated into the employee location and delivery preference database. Finally, access to the updated schedule location and delivery preferences is provided to facilitate the delivery of the message to the recipient in a timely manner. (See page 3, line 28 to page 8, line 1 of the Specification).

The present claimed invention further provides a computer system involving a module to compile a database containing recipient's scheduled locations, the recipient's delivery preferences and the corporation's preferences and the compiled database. A component provides access to the database for the recipients and the system administrator. An editing module allows the recipient or system administrator to update the recipient's scheduled locations and preferences. Alternatively, a component provides access to the corporation's schedule organizer and which allows the recipient to update the recipient's scheduled location(s) in the corporate schedule organizer. A module monitors corporate schedule organizer for location change(s) in the recipients schedule and automatically updates the employee location database with the schedule location changes. Finally, a component provides access to updated schedule(s) to

facilitate delivery of a message to recipient at the updated scheduled location. (See page 9, line 26 to page 14, line 7).

VI.   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A.   Review is requested for the rejection of claims 1-10 under 35 §102(e) as being anticipated by U.S. Patent No. 6,157,945 to Balma (the "Balma patent").

VII.   ARGUMENTS

A.   **Claims 1-10 currently stand rejected under 35 USC §102(e) as being anticipated by U.S. Patent No. 6,157,945 to Balma (the "Balma patent").**

As Appellant discusses in detail below, the final rejection of claims 1-10 are devoid of any factual or legal premise that supports the position of unpatentability. It is respectfully submitted that the rejection does not even meet the threshold burden of presenting a prima facie case of unpatentability. For this reason alone, Appellants are entitled to grant of a patent. In re Oetiker, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

A.   <u>Balma does not disclose the "Corporate Preference" feature</u>

Each of the independent claims of the subject application (namely, 1, 5 and 7-10) include the recitation a database containing a "corporation's preference" in addition "recipient's delivery preference". Further, claims 7 and 10 contain recitations concerning "setting priority of conflicting corporate and recipient preference" (see claim 7). The advantage of providing a "corporate preference" is that an administrator of the system may provide corporate rules for forwarding messages, which corporate rules may override all corporate user's "recipient's delivery preference."

With respect to the messaging system of the Balma patent, only user defined delivery preferences are taught. There are no teachings for providing a "corporate [delivery] preference". In making the rejection, the examiner does make reference to col.4, lines 51-61 of the Balma patent for allegedly disclosing a "corporate preference".

However, inspection of this reference indicates it only discloses prescribing a "default conversion" and not a "corporate preference". The difference being a "default conversion" is limited to a specific user of a corporation whereas a "corporate preference" encompasses all corporate users of the present invention system. This "corporate preference" arrangement is advantageous in the situation when a corporation may desire to temporarily ban e-mail due to virus concerns or facsimile messages due to security concerns for all corporate users. Thus, the Balma patent provides no teaching regarding a "corporate [delivery] preference" as recited in the claims of the subject application.

Therefore, it is respectfully submitted that independent claim 1, 5 and 7-10, along with their respective depending claims (2-4 and 6) patentably distinguish from the Balma patent and that the subject 35 USC §102(e) rejection be removed.

B.   <u>Balma does not disclose the "Corporate Preference" feature</u>

Each of independent claims 5 and 9 set forth a recitation regarding monitoring and updating a "corporate schedule organizer" For instance method claim 5 includes the recitations[1]:

> . . .(c) providing access to corporate schedule
>
> organizer;
>
> (d) updating recipient's scheduled location in
>
> corporate schedule organizer;
>
> (e) monitoring corporate schedule organizer for
>
> locating change in the recipient's schedule; [and]
>
> (f) updating recipient's scheduled location according
>
> to location changes monitored in (e) . .

---

[1] It is submitted independent claim 9 includes similar "system" recitations.

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Thus the present invention is able to detect if any location changes for a user is entered into a "corporate schedule organizer" (step e), and if so, then these locations changes are entered into the "recipient's location and delivery preference database of (a)." Conversely, if any location changes are detected in the aforesaid "recipient's location and delivery preference database of (a)" then these location changes are entered into the "corporate schedule organizer" (step f). In other words, the present invention reconciles the "corporate schedule organizer" with the "recipient's location and delivery preference database of (a)". This reconciliation feature provides "up-to-the minute delivery locations of employees via a database system".

With regards to the Balma patent, it does not disclose a "corporate schedule organizer" and thus nor could it disclose any reconciliation feature between a "recipient's location and delivery preference database of (a)" and a "corporate schedule organizer". In the final office action dated April 13, 2004, the examiner alleges that col. 9, line 29 to col. 10, line 8 of the Balma patent discloses a "corporate schedule organizer". A proper reading of this passage of the Balma patent reveals at best it discloses actually a database analogous to a "recipient's location and delivery preference database of (a)" and not to that of a 'corporate schedule organizer". In detail (and with reference to its Fig. 6) this passage of the Balma describes how a user prescribes "routine scheduling information which is utilized to control the forwarding of communication to the recipient". For instance, with reference to col. 9, lines 31-40, it is recited:

> After starting, in step 302 the identification of the user
>
> for whom communications are to be routed or
>
> forwarded is entered. As this system can preferably
>
> route communications for a plurality or users, step
>
> 302 is performed in order to identify the particular
>
> recipient corresponding to the information which will
>
> be entered. In step 304, the type of scheduling

which is to be programmed is entered. The

scheduling which may be selected includes, for

example, scheduling for one day each week (e.g.,

every Wednesday), . . .

Clearly this teaching does not relate to a "corporate schedule organizer" but rather something more analogous to applicant's claimed "recipient's location and delivery preference database of (a)." This difference will become more apparent from the below discussions.

Regarding step (d) of claim 5 of the present invention ("updating recipient's scheduled location in corporate schedule organizer"), the examiner alleges that col. 10, lines 9-58 discloses this feature. However, a proper reading of this passage of the Balma patent reveals that at best it describes the process of using the forms illustrated in Figs. 7 and 8 for supplementing a user's location originally entered in step 302 when a user engages in travel. And again, the information entered by a user in step 302 of the Balma patent is actually entered into a database analogous to "recipient's location and delivery preference database of (a)". Again, a "corporate schedule organizer" is simply not utilized in the system and method of the Balma patent. This will become even more apparent below.

Regarding step (e) of claim 5 of the present invention ("monitoring corporate schedule organizer for locating change in the recipient's schedule"), the examiner alleges that col. 9, line 29 to col. 10, line 58 discloses this feature. However, this passage has nothing to do with "monitoring corporate schedule organizer for locating change in the recipient's schedule" as it only discloses the process in which a user manually enters delivery preferences via step 302 or travel changes via the forms of Figs. 7 and 8. For instance, col. 10, lines 37-43 of the Balma patent explicitly recites:

Fig. 9 is a flowchart illustrating a process for

manually entering travel information. After starting,

an identification of the user is entered in step 420.

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Next travel information is manually entered in step

422. The information which is entered may be

entered utilizing the forms illustrates in Fig. 7 and 8

and/or may include the information illustrated in Fig.

5, if desired.

Clearly, when there is a change in a user's location, the user <u>must</u> manually enter this information into a database as opposed to the system "monitoring corporate schedule organizer for locating change in the recipient's schedule" for the simply reason the Balma patent explicitly discloses this.

Lastly, regarding step (f) of claim 5 of the present invention ("updating recipient's scheduled location according to location changes monitored in (e) . ."), the examiner alleges that col. 10, lines 36-58 discloses this feature. However, as just discussed above, this passage from the Balma patent has nothing to do with "updating recipient's scheduled location according to location changes monitored in (e) . . ." since simply put, there is no system monitoring of any changes in a "corporate schedule organizer" as the user must "manually" enter any locations changes, as explicitly disclosed in the Balma patent.

Therefore, it is clearly evident that the Balma patent does not disclose, and for that matter teach or suggest, updating a user's locations in a "recipient's location and delivery preference database of (a)" based upon changes made in a separate "corporate schedule organizer." Again, the user <u>must manually</u> enter any user location changes in the Balma patent. Thus, it is respectfully submitted that independent claims 5 (along with its depending claim 6) and 9 patentably distinguish from the Balma patent for this additional reason and that the subject 35 USC §102(e) rejection for these claims be removed.

Conclusion

In Conclusion, Appellants respectfully submit that the final rejection of claims 1-10 is in error for at least the reasons given above and should, therefore, be reversed.

Respectfully submitted,

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VIII.   CLAIMS APPENDIX

Claim 1.   A method for locating a recipient of a message in a corporation using a computerized system comprising:

(a)   compiling a database of a recipient's scheduled location, the recipient's delivery preference and the corporation's preference;

(b)   providing access to recipient's location and delivery preference database of (a);

(c)   updating the recipient's scheduled location and/or delivery preference; and

(d)   allowing access to updated schedule and delivery preference to facilitate delivery of message to recipient at updated scheduled location.

Claim 2.   The method as claimed in claim 1 wherein the recipient update's the recipients scheduled location and/or delivery preference in step (c).

Claim 3.   The method as claimed in claim 1 wherein the access in step (b) is via a computer based network.

Claim 4.   The method as claimed in claim 1 wherein the access in step (b) is via the telephone.

Claim 5.   A method for locating a recipient of a message in a corporation using a computerized system comprising:

(a)   compiling a database of an recipient's scheduled location, the recipient's delivery preference and the corporation's preference;

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(b)   providing access to recipient's location and delivery preference database of (a);

(c)   providing access to corporate schedule organizer;

(d)   updating recipient's scheduled location in corporate schedule organizer;

(e)   monitoring corporate schedule organizer for location change in the recipient's schedule;

(f)   updating recipient's scheduled location according to location changes monitored in (e); and

(g) allowing access to updated schedule to facilitate delivery of message to recipient at updated scheduled location.

Claim 6. The method as claimed in claim 5 wherein the recipient updates the recipients scheduled location and/or delivery preference in step (d).

Claim 7. A method for locating a recipient of a message in a corporation using a computerized system comprising:

(a)   compiling a database of a recipient's scheduled location, the recipient's delivery preference and the corporation's preference;

(b)   providing access to recipient's location and delivery preference database of (a);

(c)   updating the recipient's scheduled location and/or delivery preference;

(d)   setting priority of conflicting corporate and recipient preference;

(e)   allowing access to updated schedules and delivery preferences to facilitate delivery of message to recipient at updated scheduled location.

Claim 8. A computer based system for locating a recipient of a message in a

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corporation using a computerized system comprising:

(a)   A component for compiling a database of an recipient's scheduled locations, the entities delivery preference and the corporation's preference;

(b)   a database containing the recipient's scheduled location, the entities delivery preference and the corporation's preference;

(c)   a component for providing access to recipient's location and delivery preference in database (b);

(d)   a component for updating the recipient's scheduled location and/or delivery preference; and

(e)   a component for allowing access to updated schedule and delivery preference to facilitate delivery of message to recipient at updated scheduled location.

Claim 9. A computer based system for locating a recipient of a message in a corporation using a computerized system comprising:

(a)   a component for compiling a database of an recipient's scheduled location, the recipient's delivery preference and the corporation's preference;

(b)   a database containing the recipient's scheduled location, the entities delivery preference and the corporation's preference;

(c)   a component for providing access to the database of (b);

(d)   a component for providing access to corporate schedule organizer;

(e)   a corporate schedule organizer;

(f)   a component for updating recipient's scheduled location in corporate schedule organizer;

(g)   a component for monitoring corporate schedule organizer for location change in the recipients schedule and updating database (b) with schedule

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location change; and

(h)   a component for allowing access to updated schedule(s) to facilitate delivery of message to recipient at updated scheduled location.

Claim 10.   A computer based system for locating a recipient of a message in a corporation using a computerized system comprising:

(a)   a component for compiling a database of a recipient's scheduled locations, the recipient's delivery preference and a corporation's preference;

(b)   a database containing recipient's scheduled locations, the recipient's delivery preference and the corporation's preference compiled in (a);

(c)   a component for providing access to recipient's location and delivery preference database (b);

(d)   a component for updating the recipient's scheduled location and/or delivery preference;

(e)   a component for setting hierarchy of conflicting corporate and recipient preference;

(f)   a component for allowing access to updated schedules and delivery preference to facilitate delivery of message to recipient at update

IX.   EVIDENCE APPENDIX

None.

X.   RELATED PROCEEDINGS APPENDIX

None.